

REMARKS/ARGUMENTS

Claims 1-6, 9-15 and 17 are pending. The claims have been revised to drop the term “solvate”, however, though no longer recited by the claim, the composition of Claim 2 could still encompass a solvate (e.g., when the composition includes a solvent). Claim 8 has been amended to remove parentheses. Claim 16 has been cancelled. Accordingly, the Applicants do not believe that any new matter has been added.

Rejection—35 U.S.C. §112, second paragraph

Claim 16 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The Applicants traverse this rejection, since the scope of this claim is definite. Nevertheless, this rejection is moot in view of the cancellation of Claim 16.

Rejection—35 U.S.C. §112, first paragraph

Claims 6, 7 and 9 were rejected under 35 U.S.C. 112, first paragraph, as lacking adequate description for the proviso: “with the proviso that when R<sup>1</sup> represents a hydrogen atom, then R<sup>2</sup> is not substituted C<sub>2</sub>-C<sub>4</sub> alkyl”. The Applicants traverse this rejection, since there is no question that the disclosure describes a genus of compounds where R<sup>1</sup> can be H or XCH<sub>2</sub>CO- and R<sup>2</sup> can be a lower (C<sub>1</sub>-C<sub>6</sub>) alkyl group which may be optionally substituted, see page 6, lines 12-15, of the specification which describes choices for R<sup>1</sup> and R<sup>2</sup>. The proviso in Claim 6 merely excises potential prior art from the claims, which is the prerogative of the Applicant, see In re Johnson and Farnham, 194 USPQ 187 (CCPA 1977):

The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirements of §112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute. All that happened here is that appellants narrowed their claims to avoid having them read on a lost interference count.

Similarly, here, the Applicants merely narrowed their claims to avoid having them read on potential prior art.

Ex parte Grasselli , 231 USPQ 393 (BdPatApp&Int, 1983) is not on point, since the negative limitations defined the base composition of a catalyst, i.e., “said catalyst being free of uranium and the combination of vanadium and phosphorous”. Clearly, the Grasselli negative limitations were *qualitative* and did not merely quantitatively limit a disclosed genus.

Ex parte Winters , 11 USPQ2d 1387 (BdPatApp&Int, 1989) is also not on point, since it concerns a claim directed to a subgenus of four specific species which Appellant asserted unexpectedly exerted superior potencies to rebut an obviousness rejection. The court found that none of these four species were described and that the specification taught away from these species. Clearly, the claim in Winters represents a *qualitative* artificial subgenus (i.e., compounds having unexpectedly superior pharmacological activities distinguishing them from a prior art genus) for which the court found no descriptive support. On the other hand, the proviso in present Claim 6 merely quantitatively narrows the scope of the generic claim and does not describe an artificial subgenus having unexpectedly superior properties.

Accordingly, the Applicants respectfully request that this rejection be withdrawn.

Rejection—35 U.S.C. §112, first paragraph

Claims 1, 2 and 5-17 were rejected under 35 U.S.C. 112, first paragraph, as lacking specific enablement for solvates. This rejection is moot in view of the amendments above removing the word “solvate”.

Moreover, the specification describes solvates of the claimed compound, see page 8, line 10, and Example 4, page 20 describes methods of preparing the compound of Claim 1 by

removing solvent under reduced pressure and recrystallizing this compound from acetone. A solvate is a compound formed by the interaction of a solute and a solvent, e.g., a hydrate in which one or more water molecules is associated with a solute. While different solvents have different capacities to interact with different solutes, it would not require undue experimentation by one of skill in the art in possession of the chemical formula in Claim 1 to determine appropriate solvents which would form solvates. If a given solvent could not form a solvate with the chemical compound described by Claim 1, it would not be covered by the claim. Accordingly, this rejection may now be withdrawn.


#### CONCLUSION

In view of the above amendments and remarks, the Applicants respectfully submit that this application is now in condition for allowance. Early notification to that effect is earnestly solicited.

Respectfully submitted,

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